

F-8028



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Yoshinori SEKINE  
Serial No. : 10/702,312  
Filed : November 6, 2003  
For : INSERT-MOLDED ARTICLE, PRODUCTION  
METHOD OF THE INSERT-MOLDED ARTICLE  
AND INK  
Group Art Unit : 1774  
Examiner : Tamra DICUS

**Certificate of Mailing Under 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450 on August 13, 2007.

Ricardo Unikel  
(Name)

  
(Signature)

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT  
APPEAL BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

On July 23, 2007, the U.S. Patent and Trademark Office ("USPTO") issued a Notification of Non-Compliant Appeal Brief ("Notification") regarding the Appeal Brief filed on June 18, 2007. The Notification states that the status of all claims on appeal has not been identified. An Amended Appeal Brief is attached herewith wherein the status of all claims on appeal has been identified.

**REMARKS**

No fee is believed due. However, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

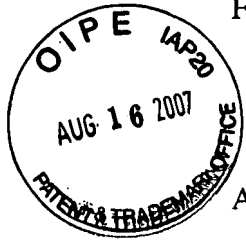
By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

BW and,

By Ricardo Unikel  
Ricardo Unikel  
Reg. No. 52,309  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

Enc. Amended Appeal Brief



F-8028

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Yoshinori SEKINE  
Serial No. : 10/702,312  
Filed : November 6, 2003  
For : INSERT-MOLDED ARTICLE, PRODUCTION  
METHOD OF THE INSERT-MOLDED ARTICLE  
AND INK  
Group Art Unit : 1774  
Examiner : Tamra DICUS

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450 on August 13, 2007.

Ricardo Unikel  
(Name)

*Ricardo Unikel*  
(Signature)

**AMENDED APPEAL BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an appeal from the final rejection of claims 1-12 in the Office Action of December 14, 2006. A Notice of Appeal was mailed to the USPTO on April 13, 2007 and received on April 16, 2007.

REAL PARTY IN INTEREST

Rights in this application are assigned to Teikoku Priority Inks Mfg. Co., Ltd., a corporation of Japan, which is the real party in interest.

RELATED APPEALS AND INTERFERENCE

None

STATUS OF CLAIMS IN THE APPLICATION

Claims 1-12 are in this application and are finally rejected. Claims 13-16 are canceled. The rejection of claims 1-12 is being appealed.

STATUS OF AMENDMENTS

There are no amendments filed after final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

As recited in independent claim 1, the invention resides in an insert molded article (page 1, first par. of the specification and Fig. 3 of the drawings) comprising a film having transparency (page 3, penultimate line, and numeral 1 of Figs. 1-3) a thermosoftening decorative print layer (page 3, last line and numeral 2 of Figs. 1-3) printed by use of a crosslinking printing ink (page 4, lines 2 and 3)

on the backside of said film (page 4, line 2 and Figs 1-3) for the purpose of visual observation from the front surface side of said film (page 3, last line, and page 4, line 1), a binder layer printed on said thermosoftening decorative print layer (page 4, lines 3 and 4, Figs 1-3), by use of a low-crosslinking printing ink or a non-crosslinking printing ink as the source of said binder layer (page 4, lines 4 and 5) and a resin molded by injection on the binder layer (page 4, lines 5 and 6 and Fig. 3 of the drawing with the explanation of injection of molded resin 5 on page 19, lines 5-8). Additional explanation of the numbered parts of the figures of the drawings are on pages 15-20 of the specification.

Claims 3 and 4, which are dependent directly or indirectly from claim 1, further recite that the binder layer contains as the resin component a low-crosslinking resin component that has a crosslinking degree lower than the crosslinking degree of the resin component constituting the thermosoftening decorative print layer (page 4, lines 9-15 and original claims 3 and 4).

Claims 7-12 which are dependent directly or indirectly from claim 1 further recite that the binder layer has transparency (page 8 lines 1-7 and original claims 7-12).

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection subject to review are as follows:

1) Whether claims 1-12 are anticipated under 35 U.S.C. 102 (e) by

Ishikawa

2) Whether claims 1-12 are anticipated under 35 U.S.C. 102 (e) by

Marentic et al.

### ARGUMENT

#### Ground 1

Whether claims 1-12 are anticipated under 35 U.S.C. 102 (e) by Ishikawa

#### Independent Claim 1 and Dependent Claims 2-12

Ishikawa discloses a resin molded product having a metallic luster layer formed on the reverse side of a transparent sheet and a synthetic resin integrally molded on the reverse side of the metallic luster layer. The product may contain a middle resin layer between the metallic luster layer and the integrally molded synthetic resin.

This rejection apparently relies on the position that Ishikawa, among other teachings, discloses that a metallic luster layer, illustrated as numeral 3 in Figs. 3 and 4, and presumed to correspond to the thermosoftening decorative print layer of the present rejected claims, is printed by use of a crosslinking printing ink. It is submitted, however, that this position is not correct. Thus, there is nothing in the text of Ishikawa that can be interpreted as teaching that the metallic luster layer is formed with a crosslinking ink. Rather, the only parts of Figs. 3 and 4 with crosslinking are middle resin layers 6, 7 and 8. Therefore, there appears to be no support for a rejection under 35 U.S.C. 102 (e) based on anticipation by Ishikawa.

It is noted that the "Response to Arguments" section of the Office Action of December 14, 2006 finally rejecting the claims points out that the middle layer



7 of Fig. 4 of Ishikawa contains a crosslinking agent and middle layer 8 may contain a crosslinking agent.

It is submitted that, regardless of the number of middle layers disclosed by Ishikawa as cross-linked, the fact remains that the metal luster layer, which is the only decorative layer disclosed by Ishikawa, is not crosslinked.

To justify this rejection, the final Office Action apparently concludes that the combination of an uncrosslinked metallic luster layer and one or more middle crosslinked layers, as disclosed by Ishikawa, is the same as a single crosslinked thermosoftening decorative print layer as claimed by applicant. However, no reason is given in support of this conclusion. For the foregoing reasons, the rejection of claim 1 and its dependent claims as anticipated by Ishikawa is not well taken and should be reversed.

#### Dependent Claims 3 and 4

A further reason for reversing the rejection of these claims as anticipated by Ishikawa is that the reference does not disclose a specific product wherein a binder layer printed on a thermosoftening decorative print layer has a resin component having a crosslinking degree lower than that of the resin component in the thermosoftening decorative print layer, which in Ishikawa is not described as having any degree of crosslinking at all.

Dependent Claims 7-12

A further reason for reversing the rejection of these claims as anticipated by Ishikawa is that the reference does not disclose a specific product wherein a transparent binder layer printed on a thermosoftening decorative print layer is merged with a resin by injection molding.

Ground 2

Whether claims 1-12 are anticipated under 35 U.S.C. 102 (e) by Marentic et al.

Independent Claim 1 and Dependent Claims 2-12

Marentic et al. discloses decorative transfers and their application to a mold surface in the production of molded products, The decorative transfers may comprises a backing, one or more intermediate layers and a protective liner. The intermediate layers comprise tacky and/or tack-free resins and inks with the resins made of crosslinkable polymers.

It is believed that this rejection is not sound, since, despite the diverse disclosure of Marentic et al., there is no teaching of a single embodiment which can be identified as including all the elements of the present claimed invention, a required for anticipation under 35 U.S.C. 102. This principle is supported, for example, in the MPEP, 8<sup>th</sup> Edition, Section 2131 which cites the holdings of several Federal Circuit court decisions including, in particular, Richardson v.

Suzuki Motor Co., 9USPQ 2<sup>nd</sup> 1913, 1920, which states that "The identical invention must be shown in as complete detail as is contained in the ...claim." Moreover, there is nothing in the Office Action of December 14, 2006 finally rejecting the claims, including the "Response to Arguments" section involving the Marentic rejection, which is believed to overcome this argument. Note that while the Office Action identifies several portions of the Marentic disclosure intended to support the rejection, there is no identification of a single embodiment in which there is an element included within every element recited in applicant's independent claim 1. To the contrary, it is noted, for example, that none of Figures 1 to 8 of Marentic discloses an insert-molded article comprising a transparent film on the backside of which is a thermosoftening decorative print layer printed by use of a crosslinking printing ink for the purpose of visual observation from the front surface side of the film, a binder layer printed on the thermosoftening decorative print layer by use of a low-crosslinking or non-crosslinking printing ink as the source of the binder layer, and a resin molded by injection on the binder layer, as recited in applicant's claim 1. For the foregoing reasons, the rejection of claim 1 and its dependent claims as anticipated by Marentic et al. is not well grounded and should be reversed.

#### Dependent Claims 3 and 4

A further reason for reversing the rejection of these claims as anticipated by Marentic et al. is that the reference does not disclose a specific product wherein a binder layer printed on a thermosoftening decorative print layer has a resin component having a crosslinking degree lower than that of the resin component in the thermosoftening decorative print layer.

#### Dependent Claims 7-12

A further reason for reversing the rejection of these claims as anticipated by Marentic et al. is that the reference does not disclose a specific product wherein a transparent binder layer printed on a thermosoftening decorative print layer is merged with a resin by injection molding.

In view of the foregoing arguments, reversal of the final rejection and allowance of all the claims on appeal are earnestly solicited.

CLAIMS APPENDIX

1. An insert-molded article, comprising a film having transparency, a thermosoftening decorative print layer printed by use of a crosslinking printing ink on the backside of said film for the purpose of visual observation from the front surface side of said film, a binder layer printed on said thermosoftening decorative print layer by use of a low-crosslinking printing ink or a non-crosslinking printing ink as the source of said binder layer, and a resin molded by injection on said binder layer.

2. The insert-molded article according to claim 1, wherein said thermosoftening decorative print layer contains as the resin component, a crosslinked polyester resin.

3. The insert-molded article according to claim 1, wherein said binder layer contains as the resin component a low-crosslinking resin component that has a crosslinking degree lower than the crosslinking degree of the resin component constituting said thermosoftening decorative print layer.

4. The insert-molded article according to claim 2, wherein said binder layer contains as the resin component a low-crosslinking resin component that

has a crosslinking degree lower than the crosslinking degree of the resin component constituting said thermosoftening decorative print layer.

5. The insert-molded article according to claim 1, wherein said binder layer contains as the resin component one or more types of resins selected from vinyl chloride (co) polymer, (meth) acrylic resin and polyester resin.

6. The insert-molded article according to claim 2, wherein said binder layer contains as the resin component one or more types of resins selected from vinyl chloride (co) polymer, (meth) acrylic resin and polyester resin.

7. The insert-molded article according to claim 1, wherein said binder layer has transparency.

8. The insert-molded article according to claim 2, wherein said binder layer has transparency.

9. The insert-molded article according to claim 3, wherein said binder layer has transparency.

10. The insert-molded article according to claim 4, wherein said binder layer has transparency.

11. The insert-molded article according to claim 5, wherein said binder layer has transparency.

12. The insert-molded article according to claim 6, wherein said binder layer has transparency.

EVIDENCE APPENDIX

None.



RELATED PROCEEDINGS APPENDIX

None.

SUMMARY

Attached hereto is an Appendix containing the claims 1-12 on appeal.

The official Appeal Brief fee of \$500.00 has been paid already. No fee is believed due. However, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,

JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

B and,

By Ricardo Unikel  
Ricardo Unikel  
Reg. No. 52,309  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340